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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,589	12/01/2000	Erik Krimm	225/49427	1848

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EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/04/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,589

Applicant(s)

KRIMM ET AL.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 9-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a plate-like functional component, classified in class 74, subclass 473.21.
- II. Claims 9-19, drawn to a method of producing a plate-like functional component, classified in class 29, subclass 524.
- III. Claims 20-25, drawn to a gate plate, classified in class 74, subclass 473.21.
- IV. Claims 26-32, drawn to a method of making a gate plate, classified in class 29, subclass 524.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the plate-like functional component can be made by another and materially different process such as plastic injection molding.

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Inventions I and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a part for a watch and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not used together and invention I is for making a plate-like functional component of an automatic gearshift mechanism and invention IV is for making a gate plate for an automatic gearshift mechanism.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

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operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, the inventions are not used together and invention II is a method of making a functional component while invention III is directed to a gate plate.

Inventions III and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the gate plate can be made by injection molding instead of stamping metal parts.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Gary R. Edwards on 12/19 a provisional election was made with traverse to prosecute the invention of group I, claims 1-8. Applicant in replying to this Office action must make affirmation of this election. Claims 9-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the three stamped parts bear flat against one another (claim 1) and the stamped parts are riveted, soldered, or welded together (claim 3) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Applicant is reminded that the each of the three stamped parts bare flat against an elastomeric plastic cover.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1-8 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Regarding claim 1, the phrase "plate-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Furthermore, the limitation "the --a-- form of a gate plate" in lines 1-2 is unclear. Since the gate has not structurally being defined, it is uncertain what the form of the functional component comprises. The limitation "in sandwich form" in line 5 renders the claim uncertain since the claim does not structurally define sandwich form. The limitation "a middle stamped part" in line 11 is unclear whether the middle stamped part is an additional part besides the at least three stamped parts or one of the at least three stamped parts is the middle stamped part.

Regarding claim 6, the limitation "and/or" in line 4 is indefinite.

Regarding claims 2-5, 7 and 8, these claims contain numerous ambiguities.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by the European publication EP-974,776 A2.

Regarding claim 1, the European patent '776 discloses in Figures 1, 3 and 4 a plate functional component comprising at least three stamped parts **11, 12, 13**. One of the stamped parts **11, 12, 13** is a middle stamped part **11**. The stamped parts **11, 12, 13** bare flat against one another. The stamped parts **11, 12, 13** are unreleasably connected to one another and each of the stamped parts **11, 12, 13** have at least two engagement holes **2, 7**. The engagement holes **2, 7** are arranged congruently with respect to one another. At least one of the engagement holes **2, 7** in the middle stamped part **11** has a hole wall **16** provided with an elastomeric plastic cover **24**.

Regarding claim 2, Figure 4 discloses the elastomeric plastic cover **24** is formed from plastic borders **18, 25**. The plastic borders **18, 25** are secured in undercuts **26** or cutouts of the middle stamped part **11** and surround a hole edge **A**.

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Regarding claim 4, the plastic cover **24** is around a hole edge **A**. Applicant is reminded that the method of forming the plastic cover by injection-moulding plastic is not germane to the issue of patentability of the functional component itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the European publication EP-974,776 A2.

Regarding claim 3, the European publication'776 fails to disclose the stamped parts are riveted, soldered or welded together. The examiner takes Official Notice that stamped parts are riveted, soldered, welded, bolted, or cemented to join the plates together. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to rivet, solder, weld, bolt, or cement the stamped parts to join the parts together.

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Regarding claim 8, the European documentation discloses two of the stamped parts **11, 12, 13** are outer stamped parts **12, 13** and the functional component further comprises spacer lugs **22**. However, the European patent fails to disclose the spacer lugs **22** formed from a material that is harder than the outer stamped parts **12, 13**. Applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select plastic for the stamped parts and metal, a harder material, for the spacer lugs. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

Claims 5-7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax number for the organization where this application or proceeding is assigned is 703-305-3597 for regular communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3620

E.G.

January 2, 2002